IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION NO.3579 OF 2006

In

SUIT NO.2961 OF 2006

Marico Limited : Plaintiff

V/s.

Raj Oil Mills Limited : Defendant

...

Dr.Virendra Tulzapurkar with Mr.F. Pooniwalla and Mr.N. Master i/b. M/s.Crawford Bayley & Co., for the plaintiff.

Mr.Ravi Kadam, Advocate General, with Mr.V.R.Dhond i/b. M/s.Avesh Kayser for the defendant.

...

CORAM : S.A.BOBDE, J.

DATE : FEBRUARY 27, 2007.

ORAL ORDER :

1. By this Notice of Motion, the plaintiff seeks an injunction restraining the defendant from infringing or pirating the registered design of the plaintiff and from manufacturing or selling any article embodying the plaintiff's registered design or applying the plaintiff's registered design or any imitation thereof to/on/upon the bottle caps of the defendant's products or any other

article. The plaintiff claims a registered design in respect of a stylized bottle cap used on their bottle while selling their coconut oil under the brand name "Parachute". Their registration certificate is at exh.‘B’ along with photographs of their registration. The cap in respect of which the design is registered is a plastic cap with a plastic lid on the cap which moves on a plastic hinge which has the contours of a butterfly.

2. The defendant use a similar cap with a similar movable lid and a hinge in plastic also with a contour of a butterfly. There is, however, a slight difference in the shape of the lid. The lid of the plaintiff’s cap has sharp indentation whereas the lid on the defendant’s cap has curved indentation.

3. The cap which is threaded from inside is admittedly used by both the parties to close their bottles containing coconut oil. It is, in that sense, a part of the bottle.

4. In the ordinary course, the plaintiff might have been entitled to an injunction on the basis of the registered design of the cap because of similarity of the defendant’s cap with that of the plaintiff. A plaintiff with a registered design will ordinarily be entitled to an injunction if the design is validly registered. However,

under the Designs Act, 2000, it is open to a defendant to raise, inter alia, the plea that the plaintiff's design is not registrable as a ground of defence. In fact, under sub-section (3) of section 22, the defendant can raise every ground on which the registration of a design may be cancelled under section 19 as a defence.

5. The defendant's contention in this case is that the plaintiff's design in respect of the cap is not registrable under the Designs Act, 2000, hereinafter referred to as the "Act". Since under the Act, 'design' means the features of shape, configuration, etc., applied to an article, a design can only be registered in respect of an article. According to the defendants, the registration of the design obtained by the plaintiff is not valid since the the cap cannot be considered to be an article "as defined in section 2(a). "Article" is defined in section 2(a) as follows:-

> "(a) "article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately."

The contention is, that it is the cap which may be

loosely called an article is nontheless, not an article since it does not stand alone as an article for sale nor can it be described as a part of an article because it is not capable of being sold separately.

6. What falls for consideration is whether the stylised cap is an article within the meaning of section 2(a) of the Act. Firstly, it does not stand alone as an article. It must, therefore, be considered to be a part of an article. Even if it is treated as a part of an article, it can be treated as an article as defined if it is capable of being made and sold separately. Prima facie, it is therefore necessary to see if the cap is capable of being made and sold separately. Undoubtedly, there is no difficulty about the applicability of the first part of the phrase "being made and sold separately". The cap indeed like any other article can be made separately. However, the law requires the article to be capable of being sold separately also.

7. The question is, therefore, whether the law simply requires that an article should be capable of being sold separately at all or whether it can be put up for sale in the market separately. With reference to the last part of the phrase, it is vehemently contended by Dr.Tulzapurkar, the learned counsel for the plaintiff,

that it is possible for a manufacturer of the cap to sell such a cap not only to the defendant but to anybody else who may wish to buy it. Therefore, anyone who may need the cap for a bottle to which it can fit may purchase it and in that sense, it is capable of being sold separately. This argument, however, does not appear to meet the intention of Parliament in enacting the definition. It appears that Parliament intended that an article must be capable of being made and sold separately in the sense that the article has a commercial identity in the market of its own and not when incorporated as a part of another article. In the present case, the defendant has filed an affidavit of the manufacturer who manufactures and sells the cap listed at exh.6 to the defendant's affidavit-in-reply to the effect that the cap in question is manufactured by using a mould prepared according to the requirements of the defendant for their bottle. Such a cap cannot be considered as capable of being sold separately merely because it may coincidentally fit another similar bottle which someone may have. In fact, it would be useful to consider the example of a cap manufactured for a fountain pen. If a cap is made specifically for a particular fountain pen, it is possible that by accident, it might fit in another fountain pen and, therefore, a person who owns or manufactures another fountain pen may purchase a cap

meant for another pen. That would, however, not mean that the cap is capable of being sold separately merely because some other use may be found for it. The cap must be considered as being made and meant for sale as a part of a particular fountain pen and not capable of being sold separately. It appears that Parliament has used the terms ‘capable of being sold separately in this case’.

8. Mr.Kadam, the learned Advocate General appearing for the defendant, relied on a decision of the House Lords in Ford Motor Co. Ltd.’s Design Applications, reported in (1995) R.P.C. 167. A similar provision in the English statute reads as follows:-

> "If that part is to be made and sold separately."

The House Lords observed as follows:-

> "My Lords, for these reasons I have been compelled to give up the attempt to read the words of the definition literally, and will instead look behind them for the intention of the legislature. In my opinion the purpose was to distinguish between on the one hand, an item designed for incorporation, whether

> as a spare part or as an original component, in a particular article or range of articles made by the manufacturer of the component, and on the other an item designed for general use, albeit perhaps aimed principally at use with manufacturer's own artifacts. Whilst it is often unwise to restate the effect of a statute in different words, since this may lead to the new formula being subjected to the kind of textual analysis which ought to be reserved to the statute itself, an answer will I believe be supplied in many cases by applying the criterion given by McCowan L.J., namely: that to qualify under section 44(1) a spare part has to have an independent life as an article of commerce and not be merely an adjunct of some larger article of which it forms part."

I am in respectful agreement with the said judgement and also of view that the Indian statute should not be read literally. Merely because a part of the article can be made separately and sold separately, it should not be taken as covered by that phrase unless the part has an identity in the market by itself. Indeed, a part must have an independent life as an article of commerce and

not be merely an adjunct of some larger article of which it forms part. The cap involved in the present case cannot be said to have an independent life of an article of commerce.

9. In my view, therefore, prima facie, the article in question i.e. the cap in which the plaintiff has a registered design was not an article within the meaning of section 2(a) which was capable of registration. The plaintiff, therefore, does not have a prima facie right to an injunction to restrain the defendant from using a similar cap.

10. In this view of the matter, it is not necessary to consider the other contention that the defendant's adoption of the cap is justified on the ground of functionality, etc.

11. The defendant also resisted this application for injunction on the ground of delay. According to the defendant, they started using the cap on their bottle since July 2004 to the plaintiff's knowledge. The plaintiff has acquiesced in use of such cap. According to the defendant, their adoption of the cap is innocent in the sense that the defendant obtained the design from public domain. However, in the view that I have taken,

it is not necessary to deal with this contention.

12. In the circumstances, there is no merit in the Notice of Motion which is hereby dismissed.

S.A. BOBDE, J.